

## **REMARKS/ARGUMENTS**

The present application includes claims 1–36 and 38 are pending. Claim 37 was previously cancelled. In the outstanding Office Action, claims 1–36 and 38 are rejected. Reconsideration and allowance of claims 1–36 and 38 are respectfully requested in view of the above amendments and the following remarks.

### **Rejections under 35 U.S.C § 102(b)**

Claims 1-12, 15, 16, 18-26, 28-30, 32-36 and 38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,439,064 to Patton (hereinafter “Patton”).

Independent claim 1 requires transmitting a command from the offsite control center to a transceiver positioned in the at least one wellbore, wherein the command alters a trajectory of the downhole drilling tool and is based on the analysis of the wellsite parameters.

However, Patton only discloses that:

The surface control center 20 and the operator's offices 12 have real time 2-way communication via telephone, radio, or satellite providing the operator the ability to monitor and control the drilling operation from his office. Consequently, much information about the drilling operation and the formation being drilled are available real time at the surface and in the operator's offices 12. Surface managers, using this information as an aid, may, if desired, communicate 2-way real time 18 with the downhole system giving it new data or operating instructions.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 213, citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...

claim." MPEP 2131 citing, Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Nowhere does Patton disclose transmitting a command from the offsite control center to a transceiver positioned in a wellbore as required by claim 1. Instead, Patton merely discloses that the surface control center 20 and the operator's office 12 have real time two-way communication. Patton also discloses that the operator may control the drilling operation from his office. However, nowhere does Patton disclose that a command is sent from the offsite control center to a transceiver positioned in a wellbore. Although Patton fails to disclose how a the drilling operation would be controlled from the operator's office, it does require "surface managers...[to] communicate two-way real time 18 with the downhole system." The real time communication 18 is accomplished by an MWD. Therefore, Patton fails to disclose transmitting a command from the offsite control center to a transceiver positioned in a wellbore as required by claim 1.

Furthermore, Patton fails to disclose that the command alters a trajectory of the downhole drilling tool and is based on the analysis of the wellsite parameters as required by claim 1. It appears that the Examiner has extrapolated that Patton discloses such a limitation based solely on the following sentence: "The surface control center 20 and the operator's offices 12 have real time 2-way communication via telephone, radio, or satellite providing the operator the ability to monitor and control the drilling operation from his office." However, extrapolating teachings outside of the disclosure is not permissible under 35 U.S.C. 102. Furthermore, the limitation is clearly not enabled by such a statement. "[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation . . . ." Transclean Corp. v. Bridgewood Servs., Inc., 290 F.3d 1364, 1373 (Fed. Cir. 2002).

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Cont'l Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (quoting In re Oelrich, 666 F.2d 578, 581 (CCPA 1981)); see also Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295 (Fed. Cir. 2002) ("Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." (quoting In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999))). The Examiner is implying that certain limitations required by the claims may be present or are probably present, and, as a result, Applicants respectfully request that the Examiner immediately withdraw the rejection. Therefore, Applicants assert that the rejection of claim 1 is improper and should be withdrawn.

With respect to independent claim 19, claim 19 requires a wellsite transceiver positioned in the wellbore for sending signals from and receiving signals at the at least one wellsite. Further, claim 19 requires an offsite transceiver for sending signals from and receiving signals at the offsite location, the offsite transceiver in communication with the wellsite receiver. Still further, claim 19 requires an offsite controller adapted to automatically adjust the wellsite setup according to the analysis of the wellsite parameters.

Nowhere does Patton disclose an offsite transceiver for sending signals from and receiving signals at the offsite location, the offsite transceiver in communication with the wellsite receiver where the wellsite receiver is positioned in the wellbore as required by claim 19. There is absolutely no mention of any transceiver positioned in a wellbore that communicates with an offsite transceiver. Therefore, for at least this reason, the rejection of claim 19 is improper.

Moreover, nowhere does Patton disclose an offsite controller adapted to automatically adjust the wellsite setup according to the analysis of the wellsite parameters. Actually, the

USPTO alleges on page 2 of the Office Action that Patton discloses “automatically adjusting the wellsite setup at the wellsite (col. 5, lines 4-7); the automatic adjustments made by a surface control unit 20.” It appears that on page 3 of the Office Action, the Examiner cites “note flow chart” as disclosing this limitation. Applicants are unaware of which flow chart the Examiner is referring to and respectfully request that the Examiner specifically set forth the rejection of claim 19.

In an effort to further prosecution, Applicants will assume that the Examiner is referring to the flowchart of Fig. 15. Applicants do not see any step in the flow chart that discloses an offsite controller adapted to automatically adjust the wellsite setup according to the analysis of the wellsite parameters as required by claim 19. Therefore, the rejection of claim 19 is improper and should be withdrawn.

With respect to independent claim 33, nowhere does Patton disclose transmitting a command to automatically adjust drilling operation of the at least one drilling tool positioned within the at least one wellbore from the offsite control center based on an analysis of the wellsite parameters at the offsite control center. Patton only discloses one sentence related to controlling operation from the offsite control center, which is discussed above. This one sentence fails to disclose any automatic adjustment of any tool or operation, let alone a drilling tool positioned within the wellbore. For at least this reason, the rejection of claim 33 is improper and should be withdrawn.

With respect to independent claim 36, at least the following limitations are not disclosed in Patton: “collecting wellsite parameters from a plurality of sensors positioned at or within a first wellbore and a second wellbore,” “transmitting at least a portion of the wellsite parameters to an offsite control center” (where the wellsite parameters include information related to the first

wellbore and the second wellbore), and “determining a drilling command at the offsite control center in response to the wellsite parameters.” There is no mention of a second wellbore in Patton; and, the USPTO failed to even allege that these limitations were disclosed by Patton. Therefore, Applicants respectfully request that this rejection be withdrawn.

Claims 2-12, 15, 16, 18, 20-26, 28-30, 32, 34, 35 and 38 depend directly or indirectly from independent claims 1, 19, 33, and 36 and each add at least one additional limitation thereto. These claims are allowable for at least the same reasons set forth above with respect to claims 1, 19, 33 and 36.

Claims 13, 14, 17, 27 and 31 stand rejected as being obviousness over Patton in view of U.S. Patent No. 5,864,772 to Alvarado et al. These claims depend directly or indirectly from claims 1 or 19 and each adds an additional limitation thereto. These claims are allowable for at least the same reasons set forth above with respect to claims 1 and 19.

### **Conclusion**

Applicants have telephoned the Examiner to request a formal interview with the Examiner and his supervisor. Applicants respectfully request such an interview prior to issuance of a further Office Action. Applicants believe this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. Applicants do not believe any fee is due for filing this Response, however, if any fee is due, please apply any charges not covered or any credits, to Deposit Account 50-5149 (Reference Number 19.0372).

Respectfully submitted,

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